

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Derek CAMPBELL *et al.*

Serial No.: 10/700,043

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For: GOLF BAG BASE

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Sir:

Applicants respectfully request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated in the below remarks. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

Remarks

Having received and reviewed the final Office Action dated February 7, 2008, Applicants respectfully submit that the standing rejections are based on one or more clear errors, and that the appeal process can be avoided through a pre-appeal brief review as set forth in the Official Gazette notice of July 12, 2005.

The pending rejections fail to address all the claim limitations, and exhibit clear factual and legal errors with respect to the cited references. The specific error relied upon in this Pre-Appeal Brief Request for Review includes the following:

- The Office made clear error in relying on U.S. Patent No. 6,938,762 to Cheng (hereinafter “Cheng ‘762”), in its rejection of claims 1, 4-11, 15-16, 20-28, 33, 34, and

36, as argued in Applicant's Amendment and Response filed December 20, 2007, at pp. 12-13. In the Office's final Office Action dated February 7, 2008, the Office States that the evidence provided in Applicants' Declaration under Rule 1.131 is inadequate and inconsistent. *See* the final Office Action dated February 7, 2008 at p. 5. Applicants respectfully disagree. In the final Office Action of September 21, 2007, the Office asserts that the "declaration fails to show that the bottom is made from one piece." *See* the Final Office Action at p. 5. Applicants respectfully disagree. Several exhibits filed with the Declaration depict the bottom as being one piece. For instance, Exhibit C shows a one piece bottom. Durable inserts are shown in the figure but, as indicated in the exhibit, they are only included "as needed." *See* Declaration Exhibit C filed March 19, 2007. In addition, Exhibit D depicts the bottom as a single piece. Exhibit E also shows the base as a single unit. Additional durable inserts are shown in Exhibit E. However, these inserts, that may or may not be used in conjunction with the one piece base, do not detract from the base itself being a single piece. Exhibits F and G further illustrate a base formed of a single piece element. While additional inserts or wear guards may be used with the bag, the base itself is shown as one piece. Accordingly, Applicants respectfully assert that the Declaration filed does indeed show the base as being a single piece, as recited in independent claims 1, 20, and 38. Further, Further, the Office asserts that none of the evidence shows an indentation in the interior surface of the base, the reduced thickness, shaft with handle, etc." *See* the final Office Action dated February 7, 2008 at p. 5. Applicants respectfully assert that none of independent claims 1, 20, or 38 recite features of the bag including the indentation on the inside surface or a handle. Applicants have clearly stated in the Declaration where support for various claim features, particularly the features of independent claims 1, 20 and 38 are supported in the Declaration. Accordingly, Applicants respectfully assert that the evidence presented in the Declaration is sufficient to establish a date of conception and reduction to practice prior to May 28, 2003, the filing date of Cheng '762. Cheng '762 is therefore not valid as prior art against the present claims, and Applicants respectfully request withdrawal of these rejections.

- The Office made clear error in relying on U.S. Patent No. 6,386,362 to Cheng (hereinafter “Cheng ‘362”) in its rejection of claims 1, 6, 8-11, 15, 16, 18, 20-25, 33, and 34, as argued in Applicants’ Amendment and Request for Continued Examination filed December 20, 2008. The Office asserts that “Cheng ‘362 teaches a golf bag having a base including a one-piece element that extends around the second of the body and forms a support surface and defining a flexion line defining two pivotable portions.” *See* the final Office Action dated February 7, 2008 at p. 2. Applicants respectfully disagree. Cheng ‘362 describes a golf bag including a base seat. Col. 2, lines 43-45. The base seat includes a front section, a rear section and a pivot section connected between the front and rear sections. Col. 2, lines 65-67. Cheng ‘362 clearly fails to teach or suggest a base *formed of a single piece* element extending substantially around the second end of the body. Rather, Chang ‘362 describes a multi-part base having a pivot section (40 in Figures 1-7) that is formed of a flexible material to facilitate bending of the base. Col. 3, lines 17-20. The pivot section is *connected between* the front and rear sections. Further, Cheng describes the front and rear sections as “halves of the base seat and the pivot section is positioned at the center of the base seat.” *See* Cheng ‘362 col. 4, lines 21-23. Cheng also describes the front and rear sections as able to be “*connected* by an alternative measure” rather than by the aforesaid pivot section. *Id* at col. 4, lines 8-11. (Emphasis added) Therefore, Cheng ‘362 clearly fails to teach or suggest a base formed of a single piece element, as recited in independent claims 1 and 20. Accordingly, Applicants respectfully assert that claims 1 and 20 are patentably distinct from Cheng ‘362.
- The amendments made in the Amendment and Request for Continued Examination filed December 20, 2008 were made in response to the assertion by the Office that the previously used claim term “‘one piece’ is broad and does not exclude the other part coming together to form one piece item.” *See* the Final Office Action dated September 21, 2007 at p. 4-5. Further, the Office asserts that the amended term “single piece” is broad and does not exclude the base of Cheng ‘362. *See* the final Office Action dated February 7, 2008 at p. 4-5. While Applicants do not agree with the assertion of the Office, Applicants assert that a base made from a plurality of parts, as described in Cheng

'362, clearly can not be considered *formed of a single piece element*, as recited in claims 1 and 20.

- Dependent claims 6, 8-11, 15, 16 and 18 that depend from claim 1, as well as claims 21-25, 33, and 34 that depend from claim 20, are allowable for at least the same reasons as their respective base claims and further in view of the novel features recited therein. Applicants respectfully request withdrawal of these rejections.
- The Office made clear error in relying on U.S. Patent No. 6,568,527 to Te-Pin (hereinafter "Te-Pin") in its rejection of claims 1, 4-11, 15, 16, 18, 20-28, 33, 34 and 36, as argued in Applicants' Amendment and Request for Continued Examination filed December 20, 2007. The Office asserts that "Te-Pin teaches a golf bag having a base including a one-piece element that extend around the second of the body and forms a support surface and defining a flexion line defining two pivotable portions." Applicants respectfully disagree. Te-Pin describes a golf bag that includes a base bracket. Col. 2, lines 48-49. The base bracket includes a front section, a rear section, a first flexible section disposed on the front section, a second flexible section disposed on the rear section and a connecting member connected between the first and second flexible sections. *See* Col. 2, lines 57-61 and FIGS. 1, 2, 4 and 5. The connecting member is disposed between the first and second flexible sections and is connected with outer edges of corresponding portions thereof. Col. 3, lines 33-35. A part of the connecting member is connected with the first and second flexible sections on the bottom of the base bracket, while another part is connected with the first and second flexible sections on the lateral side of the base seat. Col. 3, lines 35-40. The first and second sections are "connected together to form a larger receiving space." Col. 3, lines 40-41.
- The Office asserts that the term "single piece" is broad and does not exclude the base of Te-Pin. *See* the final Office Action dated February 7, 2008 at p. 4-5. Applicants respectfully disagree. Clearly, Te-Pin fails to teach or suggest a base formed of a single piece element that extends substantially around the second end of the body. In fact, Te-Pin describes a base including multiple parts connected together. For instance, the connecting member of Te-Pin is "bridged and connected between the first and second flexible sections by way of stitching." Col. 4, lines 15-17. Note also Figs. 2, 4 and 5 of

Te-Pin. As such, Te-Pin specifically teaches away from a base formed of a single piece element that extends substantially around the second end of the body, as recited in claims 1 and 20. Applicants respectfully assert that independent claims 1 and 20 patentably distinguish from Te-Pin and request withdrawal of this rejection.

- Claims 4-11, 15, 16 and 18 that depend from claim 1, as well as claims 21-28, 33, 34 and 36 that depend from claim 20, are allowable for at least the same reasons as their respective base claims and further in view of the novel features recited therein. Applicants respectfully request withdrawal of these rejections.
- The Office made clear error in relying on U.S. Patent No. 6,564,937 to Cheng (hereinafter “Cheng ‘937”) in its rejection of claims 1, 4, 7-11, 15, 16, 18, 20-27, 33, 34 and 36, as argued in Applicants Amendment and Request for Continued Examination filed December 20, 2007. The Office asserts that “Cheng ‘937 teaches a golf bag having a base including a one-piece element that extend around the second of the body and forms a support surface and defining a flexion line defining two pivotable portions.” See the final Office Action dated February 7, 2008 at p. 2. Applicants respectfully disagree. Cheng ‘937 describes a golf bag including a base having a front section and a rear section. Col. 3, lines 3-4. The bottom of the front section is open and a driving board is connected to the front section via a connecting structure. Col. 3, lines 12-31. The golf bag base of Cheng ‘937 includes multiple parts. See FIGS. 2 and 3. Clearly, Cheng ‘937 fails to teach or suggest a base formed of a single piece element that extends substantially around the second end of the body. Although the Office asserts that the term “single piece” is broad and does not exclude Cheng ‘937, Applicants respectfully disagree and assert that at least independent claims 1 and 20 are patentably distinct from Cheng ‘937.
- Claims 4, 7-11, 15, 16 and 18 that depend from claim 1, as well as claims 21-27, 33, 34 and 36 that depend from claim 20, are allowable for at least the same reasons as their respective base claims and further in view of the novel features recited therein.
- The Office made clear error in relying on Cheng ‘762, Cheng ‘362, Cheng ‘937 or Te-Pin, either alone or in combination with U.S. Patent Publication No. 2004/0200746 to Kang (hereinafter “Kang”) or U.S. Patent No. 3,941,398 to Nelson (hereinafter “Nelson”)

in its rejection of claims 2, 29, 30, 38, 40-43, 46 and 47, as argued in Applicants Amendment and Request for Continued Examination filed December 20, 2007. Claims 2 and 29-30 depend from claims 1 and 20, respectively. As discussed above, none of the Cheng references or Te-Pin teaches or suggests all the features of claims 1 and 20. The addition of Kang or Nelson fails to cure the deficiencies of the Cheng references or the Te-Pin reference with respect to claims 1 and 20. Accordingly, Applicants respectfully assert that claims 2, 29 and 30 are allowable for at least the same reasons as their respective base claims and further in view of the novel features recited therein.

- The Office asserts that the Kang and Nelson references teach a base made of foam. However, this feature is not recited in independent claim 38. Independent claim 38 recites features similar to those recited in claims 1 and 20. For example, claim 38 recites, among other features, “[a] golf bag comprising: ...a base secured to the second end of the body, the base *formed of a single piece* element that extends substantially around the second end of the body” (Emphasis added). None of Cheng ‘762, Cheng ‘362, Cheng ‘937 or Te-Pin teaches or suggests the features of claim 38. The addition of Kang or Nelson fails to cure the deficiencies of these references with respect to claim 38 because neither Kang nor Nelson, alone or in combination, teaches or suggests this base formed of a single piece element. Accordingly, Applicants respectfully assert that claim 38 is allowable over the cited references.
- Claims 40-43, 46 and 47 that depend from claim 38 are allowable for at least the same reasons as discussed above and further in view of the novel features recited therein. Applicants respectfully request withdrawal of this rejection.

- The Office made clear error in relying on Cheng '763, Cheng '362, Cheng '937 or Te-Pin, either alone or in combination with U.S. Patent No. 6,648,137 to Hamamori (hereinafter "Hamamori") or U.S. Patent No. 6,298,988 to Wen-Chien (hereinafter "Wen-Chien") in its rejection of claims 12-14, 31, 32, 35-37, 44, and 45, as argued in Applicants Amendment and Request for Continued Examination filed December 20, 2007.
- Claims 12-14 that depend from claim 1, as well as claims 31, 32 and 35-37 that depend from claim 20, and claims 44 and 45 that depend from claim 38, are allowable for at least the same reasons described above with respect to their respective base claims. The addition of Hamamori or Wen-Chien fails to cure the deficiencies of the Cheng references and Te-Pin with respect to independent claims 1, 20 and 38. Accordingly, Applicants respectfully assert that dependent claims 12-14, 31, 32, 35-37, 44 and 45 are allowable over the cited combination of references.
- The Office made clear error in relying on Cheng '762, Cheng '362, Cheng '937 or Te-Pin, either alone or in combination with U.S. Patent No. 6,634,497 to Chang (hereinafter "Chang") or U.S. Patent No. 5,941,383 to Cheng (hereinafter "Cheng '383") in its rejection of claims 48-55. The Office asserts that either Chang or Cheng '383 teaches that it is known in the art to provide feet elements having different configurations. *See* the final Office Action dated February 7, 2008 at p. 3-4. Applicants respectfully disagree. None of the Cheng references or Te-Pin teaches or suggests the features of independent claim 48. For example, none of the Cheng references or Te-Pin teaches or suggests at least a first and second wear element. The addition of Chang or Cheng '383 fails to cure the deficiencies of the Cheng references or Te-Pin with respect to claim 48. None of the cited references, alone or in combination, teaches or suggests a first wear element and a second wear element having different configurations. Rather, the Chang '497 and Cheng '383 each recite a wear element. The wear elements have a configuration. However, neither Chang '497 nor Cheng '383, nor any of the cited references, teaches or suggests *two wear elements having two different configurations*, as recited in claim 48. Accordingly, Applicants respectfully assert that claim 48, as well as claims 49-55 that depend therefrom, are allowable over the cited references

- Additionally, claims 17-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cheng '762, Cheng '362, Cheng '937 in view of JP 198250 (hereinafter "JP '250") or U.S. Patent No. 3,866,646 to Nevard (hereinafter "Nevard") or U.S. Patent No. 6,736,264 to Yoshida (hereinafter "Yoshida"). Applicants respectfully assert that none of JP '250, Nevard or Yoshida cures the deficiencies of the Cheng references with respect to claim 1, from which claims 17-19 depend. Accordingly, Applicants respectfully assert that claims 17-19 are allowable over the cited combination of references.
- Further, the Office made clear error in relying on Chang '497 or Cheng '383 in view of Hamamori or Wen-Chien and further in view of Kang or Nelson in its rejection of claims 48-55. None of the cited references, alone or in combination, teaches or suggests the features of claim 48. For instance, none of the cited references teaches or suggests a base having a first wear element and a second wear element secured to an exterior surface of the foam element, wherein *the first wear element has a first configuration and the second wear element has a second configuration, the second configuration being different from the first configuration*, as recited in claim 48. Accordingly, Applicants respectfully assert that claim 48, as well as claims 49-55 that depend therefrom, are patentably distinct from the cited combination of references.

While Applicants believe the above points represent the clearest errors made by the Office, Applicants reserve the right to appeal on other bases and errors. Applicants further reserve the right to address the rejections of any other claims not identified above on appeal should the appeal of this case proceed after the Office's consideration of this paper.

CONCLUSION

All issues having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same. However, if for any reason the review panel believes the application is not in condition for allowance or there are any questions, the review panel is invited to contact the undersigned at (202) 824-3174.

Respectfully submitted,

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